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Filed : March 4, 2002

### INTERVIEW SUMMARY

A telephone interview was conducted with Examiner Miggins on December 2, 2003 with Applicant's representative, Karoline A. Delaney. The pending claims were discussed primarily in view of Hiraoka et al (WO 97/31050) and what appears to be the U.S. counterpart of Hiraoka (U.S. Patent No. 6,485,804B1).

### REMARKS

Claims 1-16 and 24-28 are currently pending in this application. Claims 8, 17, and 29 have been cancelled. Claims 18-23 were previously cancelled. Claims 1, 10, 15, 16, and 24 have been amended. Claim 30 has been added. Reconsideration of the application in view of the following comments is respectfully requested.

#### Response to the Examiner's Rejections

##### Response to the §112 Rejection

##### The §112 Rejection of Claims 15 and 17

The Examiner has rejected claims 15 and 17 under 35 U.S.C. §112 stating that there is insufficient antecedent basis for the limitation "barrier material." Applicants have cancelled claim 17, amended claim 15, and added claim 30 to address this rejection.<sup>1</sup> The addition of claim 30 does not constitute new matter. Support for this claim may be found throughout the specification, more specifically in paragraph [0061] of the pending application. Applicants respectfully submit that these claim amendments fully address the Examiner's objections and render the claims in allowable form.

##### Response to the §102 Rejection

##### The §102(b) Rejection of Claims 1-5 as being Anticipated by Hirose et al.

The Examiner has rejected claims 1-5 under 35 U.S.C. §102(b) as being anticipated by Hirose et al. (U.S. Patent No. 4,844,987, hereinafter "Hirose"). The Examiner states, in part, that "Hirose et al. teach a laminate consisting of a first layer and a second layer (column 4, lines 22-40), the first layer comprising polyethylene terephthalate (column 4, lines 22-40), and the second layer comprising a thermoplastic material selected from the group consisting of copolyester

<sup>1</sup> For purposes of clarity, claim 16 has also been amended although it was not specifically rejected by the Examiner.

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barrier materials, phenoxy-type thermoplastics, polyamides, polyethylene naphthalate, polyethylene naphthalate copolymers, polyethylene naphthalate/polyethylene terephthalate blends, polyethylene terephthalate and combinations thereof (since polyamide is taught as the outer layer, see column 4, lines 22-40)."

Applicant respectfully submits that current amendment to claim 1, removing polyamide from the claim, renders the rejection over Hirose moot. As the Examiner has pointed out, Hirose teaches that the second layer is a polyamide, Hirose does not teach any of the other claimed thermoplastics. Accordingly, Hirose does not disclose a laminate as claimed in Claim 1 and does not anticipate claim 1 or any claim depending therefrom. Accordingly, claim 1 and all claims depending therefrom, are patentable over Hirose.

#### Response to the §103 Rejections

##### The §103(a) Rejection of Independent Claim 1 over Hiraoka in view of Hirose

The Examiner has rejected claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Hiraoka et al (WO 97/31050) in view of Hirose. As stated in our previous response, responding to this rejection is not an admission that this reference is prior art; accordingly Applicant reserves the right to swear behind this reference at a later date if desired. As the PCT publication is in Japanese, applicant refers to the U.S. national phase filing, U.S. Patent No. 6,485,804B1 (hereinafter "Hiraoka"), of the PCT publication in order to achieve a better understanding of the disclosure of Hiraoka.

There is no suggestion to combine Hiraoka and Hirose. As discussed below, the laminate disclosed in Hiraoka does not disclose the use of a first layer of PET. Hirose only teaches the use of PET and polyamide. Neither reference suggests to one of skill in the art to use other materials or to combine their teachings with any other reference. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims. As there is no suggestion to combine Hiraoka and Hirose, Applicants submit that the rejection of claims 1-5 as obvious over Hiraoka in view of Hirose is improper. Applicants respectfully submit that claim 1 and all claims depending therefrom, are patentable.

Even if the references were combined, the combination of Hiraoka in view of Hirose does not teach or suggest the laminate of claim 1 and does not render claim 1 obvious.

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The Examiner states, in part, that "Hiraoka et al teach a laminate consisting of a first layer and a second layer, the first layer comprising polyethylene terephthalate, and the second layer comprising a thermoplastic material .... (since polyamide is taught in the second layer, See English abstract provided in paper #5), and said polyethylene terephthalate in the first layer has an isophthalic acid content of at least about 2% by weight (See English abstract provided in paper #5)."

Applicants respectfully disagree with the Examiner's characterization of Hiraoka. Although Hiraoka discloses a polyester laminate, the laminate disclosed does not contain a first layer of PET and a second layer of a polyamide. Instead, the laminate disclosed comprises "[I] a first resin layer formed from the first polyester [A] or the polyester composition of the invention, and [II] a second resin layer formed from at least one resin selected from the group consisting of (a) the second polyester [B], (b) a polyamide and (c) a polyolefin." (column 3, lines 7-13). Hiraoka describes "the polyester composition of the invention" as comprising "1 to 99% by weight of the first polyester [A]." (column 2, lines 60-62).

The "novel first polyester [A]" is not the commonly known PET, rather it is a polyester comprising "polyalkylene glycol having an alkylene chain of 2 to 10 carbon atoms" (column 3, lines 42-43). Although Hiraoka does describe PET in the background section as one of the materials commonly used for containers and bottles, this description is clearly background to be distinguished from the "novel first polyester [A]." Accordingly, the "first polyester [A]" and therefore "the polyester composition of the invention" do not disclose PET as that is known to one of skill in the art. Moreover, claim 1 has been amended to remove polyamide from the claim. Therefore, Hiraoka does not teach or suggest a laminate as claimed in Claim 1 and does not render claim 1, or any claims depending therefrom, obvious.

The Examiner also states that while Hiraoka does not teach a first layer directly adhered to a second layer, "Hirose et al. teach a PET layer which is directly adhered to a polyamide layer (column 4, lines 22-40) (applies to instant claim 1) for the purpose of disposing with the costly and timely adhesive layer." Although Hirose does disclose a combination of PET and polyamide, Hirose does not teach or suggest a second layer comprising a thermoplastic material selected from the group consisting of copolyester barrier materials, phenoxy-type thermoplastics, polyethylene naphthalate, polyethylene naphthalate copolymers, polyethylene naphthalate/polyethylene terephthalate blends, polyethylene terephthalate and combinations

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thereof. Accordingly, Hirose does teach or suggest a laminate as claimed in Claim 1 and does not render claim 1 obvious.

The combination of Hiraoka in view of Hirose does not teach or suggest the laminate of claim 1 and does not render claim 1 obvious. Applicants respectfully submit that claim 1 and all claims depending therefrom, are patentable.

The §103(a) Rejection of Independent Claims 10 and 24 over Hirose in view of Farha

The Examiner has rejected claims 10, 12-15 and 24-27 under 35 U.S.C. §103(a) as being unpatentable over Hirose in view of Farha (U.S. Patent No. 5,472,753, hereinafter "Farha").

There is no suggestion to combine Hirose and Farha. As discussed below, Farha teaches one of skill in the art that in order to use a barrier layer of poly(hydroxyamino ether) one must combine copolyester with poly(hydroxyamino ether) in order to adhere the poly(hydroxyamino ether)/copolyester layer to the PET layer. Hirose only teaches the use of PET and polyamide. Neither reference suggests to one of skill in the art to use other materials or to combine their teachings with any other reference. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims. As there is no suggestion to combine Hirose and Farha, Applicants submit that the rejection of claims 10, 12-15 and 24-27 as obvious over Hirose in view of Farha is improper. Applicants respectfully submit that claims 10 and 24, and all claims depending therefrom, are patentable.

Even if the references were combined, the combination of Hirose in view of Farha does not teach or suggest the subject matter of claims 10 and 24, and those claims depending therefrom, and does not render these claims obvious.

The Examiner states, in part, that "Hirose et al. teach a laminate ... wherein the laminate consists of first and second layers ... and wherein the first layer comprising polyethylene terephthalate ... and wherein the second layer comprising a thermoplastic material ... since polyamide is taught as the outer layer ..."

Applicant notes that Independent claims 10 and 24 have been amended to remove polyamide. Moreover, as stated above, Hirose does not teach or suggest, either alone or in combination with Farha, a second layer comprising a thermoplastic material selected from the group consisting of copolyester barrier materials, phenoxy-type thermoplastics, polyethylene naphthalate, polyethylene naphthalate copolymers, polyethylene naphthalate/polyethylene

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terephthalate blends, polyethylene terephthalate and combinations thereof. Accordingly, Hirose does teach or suggest a laminate as claimed in Claim 10 or a container or preform as claimed in claim 24 and does not render these claims, or claims that depend therefrom, obvious.

The Examiner further relies on Farha stating, in part, that "Farha teaches a pre-form or container comprising a neck portion and a body portion ..., and a barrier material which is a poly(hydroxyamino ether) bonded to a PET layer (albeit with a certain amount of copolyester in the poly(hydroxyamino ether layer column 35-50 and column 10, lines 15-21) ..."

Farha does not teach or suggest, either alone or in combination with Hirose, the subject matter of claims 10 and 24. As the Examiner notes Farha requires that a "certain amount of copolyester [is] in the poly(hydroxyamino ether) layer..." Accordingly, Farha teaches one of skill in the art that in order to use a barrier layer of poly(hydroxyamino ether) one must combine copolyester with poly(hydroxyamino ether) in order to adhere the poly(hydroxyamino ether)/copolyester layer to the PET layer. Therefore Farha does not teach or suggest the subject matter of claims 10 and 24 and in fact teaches away from the use of poly(hydroxyamino ether) directly bound to PET.

Moreover, the combination of Hirose in view of Farha does not teach or suggest the subject matter of claims 10 and 24, and those claims depending therefrom, and does not render these claims obvious. Applicants respectfully submit that claims 10 and 24, and all claims depending therefrom, are patentable.

The §103(a) Rejection of Independent Claim 10 over Hiraoka in view of Farha

The Examiner has rejected claims 10 and 13-15 under 35 U.S.C. §103(a) as being unpatentable over Hiraoka in view of Farha.

There is no suggestion to combine Hiraoka and Farha. As discussed above, neither Farha or Hirose suggests to one of skill in the art to use other materials or to combine their teachings with any other reference. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims. As there is no suggestion to combine Hiraoka and Farha, Applicants submit that the rejection of claims 10 and 13-15 as obvious over Hirose in view of Farha is improper. Applicants respectfully submit that claims 10 and 13-15 and all claims depending therefrom, are patentable.

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Even if the references were combined, the combination of Hiraoka in view of Farha does not teach or suggest the subject matter of claims 10 and 13-15, and those claims depending therefrom, and does not render these claims obvious.

The Examiner states, in part, that "Hiraoka et al teach a laminate ... the first layer comprising polyethylene terephthalate, and the second layer comprising a thermoplastic material ... (since polyamide is taught as the second layer)." The Examiner further states that "it would have been obvious to one of ordinary skill in the art ... to have provided a pre-form or container ... wherein the barrier material is a poly(hydroxyamino ether) in the container of Hiraoka et al. in order to provide good oxygen barrier properties ... as taught or suggested by Farha."

As explained above, although Hiraoka discloses a polyester laminate, the laminate disclosed does not contain a first layer of PET and a second layer of a polyamide. Accordingly, Hiraoka does not teach or suggest a laminate as claimed in Claim 10 and does not render claim 10, or any claims depending therefrom, obvious. Further, as discussed above, Farha does not teach or suggest the subject matter of claim 10 and in fact teaches away from the use of poly(hydroxyaminoether) directly bound to PET.

Moreover, the combination of Hiraoka in view of Farha does not teach or suggest the subject matter of claim 10, and those claims depending therefrom, and does not render these claims obvious. Applicants respectfully submit that claim 10, and all claims depending therefrom, are patentable.

The §103(a) Rejection of Independent Claim 24 over Hiraoka in view of Farha and Hirose

The Examiner has rejected claims 24-27 under 35 U.S.C. §103(a) as being unpatentable over Hiraoka in view of Farha and Hirose.

There is no suggestion to combine Hiraoka with Farha and Hirose. As discussed above, neither Hiraoka, Farha, or Hirose suggests to one of skill in the art to use other materials or to combine their teachings with any other reference. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims. As there is no suggestion to combine Hiraoka, Farha, and Hirose, Applicants submit that the rejection of claims 24-27 as obvious over Hiraoka in view of Farha and Hirose is improper. Applicants respectfully submit that claims 24-27, and all claims depending therefrom, are patentable.

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Even if the references were combined, the combination of Hiraoka in view of Farha and Hirose does not teach or suggest the subject matter of claims 24-27, and those claims depending therefrom, and does not render these claims obvious.

As explained above, the combination of Hiraoka in view of Farha does not teach or suggest the subject matter of claim 24, and those claims depending therefrom, and does not render these claims obvious. Moreover, the disclosure of Hirose in combination with Hiraoka and Farha does nothing to overcome the lack of a teaching or suggestion of the subject matter of claim 24, and those claims depending therefrom, in the cited references. Applicants respectfully submit that claim 24, and all claims depending therefrom, are patentable.

#### The §103(a) Rejections of Dependant Claims

Applicants respectfully submit that the dependent claims not specifically discussed above are patentable for at least the same reasons as the independent claims from which they depend. Moreover, applicants respectfully submit that the dependent claims include distinct limitations that render them patentable over the cited references.

#### Conclusion

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If, however, any questions remain, Examiner is cordially invited to contact the undersigned so that any such matters may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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